

REMARKS**I. Status of the Claims**

Upon entry of this amendment, claims 1, 2, 5-6, 8, 11-12, 24-34 are pending in this application. Claims 7, 9, 10, 13-16 and 18-23 have been withdrawn from consideration and were previously cancelled without prejudice or disclaimer. Claims 3 and 17 have been cancelled without prejudice or disclaimer by this amendment. Claims 1 and 24 are amended herein, and claims 30-34 are newly-added by this amendment. No excess claim fee is believed due. Authorization is hereby given to charge Deposit Account No. 50-0369 in connection with any fees for extension of time or other fee that may be necessary to permit entry of this response.

Reconsideration and allowance of all pending claims are requested in view of the remarks below. While entry of a typical Amendment after a Final Office Action is subject to 37 CFR 1.116, Applicant notes that a petition to withdraw the finality of the Office Action mailed December 28, 2004 has been filed on even date with this amendment, as detailed further below. A copy of the petition is also enclosed herewith for the Examiner's convenience. Evaluation of entry of this amendment is thereby requested under 37 CFR § 1.111(a)(1).

II. Interview Summary

Applicant thanks the Examiner for the telephone interview conducted February 11, 2005. Applicant also thanks the Supervisory Examiner for the telephone conversation conducted February 15, 2005. The Interview Summary from the Examiner, mailed March 1, 2005, has been received. In response, Applicant's Representative provides the following Interview Summary.

Applicant's Representative emphasized that each of the claims was patentable over Wong '210 without amendment. However, in an effort to seek agreement on the allowability of claim 24,

Applicant's Representative suggested capital T-related language to seek to address the Examiner's concerns raised during the telephone interview, solely to expedite approval and not for matters of patentability. Applicant's Representative herein again notes, as stated during the interview, that Claim 24 does not require amendment to be patentable over Wong '210. Applicant's Representative noted that the Final Office Action did not address Claims 24-29 in detail.

Applicant's Representative disagrees that the Representative insisted that the Examiner indicate allowable subject matter during the interview. Applicant's Representative acknowledged several times during the interview that the Examiner does not need to commit to allowability of the claims if they overcome the cited reference, as additional art may be located. However, Applicant's Representative anticipated that the Examiner would have been able to identify issues and resolve differences as to the status of the claims as presently pending in view of the one-reference rejection. See MPEP § 713.01. Applicant's Representative was seeking to develop and clarify specific issues to lead to a mutual understanding between the Examiner and the Applicant, thereby advancing prosecution. Applicant's Representative respectfully notes that the Examiner made no suggestions for potential claim amendments, nor offered ideas to resolve remaining concerns. Applicant's Representative notes that MPEP § 713.01 provides that should the Examiner need additional time to restudy the situation, the call should be terminated with an agreement that the Examiner will call back at a specified time. The Examiner did not offer to do so, instead urging Applicant to file a RCE to allow for additional time for consideration of the case by the Examiner. Applicant's Representative respectfully noted that it is not atypical for a commitment from the Examiner during an interview that a particular proposed amendment, if agreeable to the parties, would overcome the present rejection. Applicant's Representative noted that a RCE would be appropriate to provide for entry of an amendment in view of a Final Office Action.

III. Information Disclosure Statements

The non-final Office Action mailed March 1, 2004 indicated that Information Disclosure Statements filed January 24, 2001, April 9, 2001, and May 23, 2002 have not been considered because they are not in the file. (January 28, 2001 is incorrectly listed as the first IDS filing date in the Office Action.) As requested, with the previous response to the non-final Office Action, copies of these Information Disclosure Statements were provided again for the Examiner's convenience on September 1, 2004, along with copies of the references cited therein provided on a CD-ROM. A fourth Information Disclosure Statement with copies of the references cited therein in paper form was also filed September 1, 2004.

As noted above, Applicant has petitioned to remove the finality of the present Office Action, as none of these Information Disclosure Statements have been considered, as confirmed by the Examiner during the February 11, 2005 telephone interview. Furthermore, Applicant notes that because the first three Information Disclosure Statements were filed before the date of the Office Action, any new rejection of the claims based on references cited therein would appropriately be a non-final Office Action.

IV. Claim Rejections – 35 USC § 102

Claims 1-2, 5, 8, 11-12, 24-27 and 29 are rejected as being anticipated by U.S. Patent No. 4,521,210 to Wong (Wong). Applicant traverses this rejection.

A. The Disclosure of Wong

Wong is directed to an eye implant for relieving glaucoma. The implant of Wong is formed to be thin, resilient, semi-rigid body having surface channels extending along its length to provide drainage passages for eye fluids. Longitudinal channels are preferably provided by corrugating the body of the device longitudinally. The Wong implant is curved along its length to match the curvature of the interior of the sclera of the eye. The implant is preferably implanted with its tip in the peripheral angle of the anterior chamber of the eye, with its central portion extending between the sclera and the ciliary body. The opposite end extends into the suprachoroidal space, wherein eye fluids drained from the anterior chamber are absorbed. See the Abstract of Wong. In summary, Wong discloses a thin, resilient implant that is curved to match the curvature of the interior of the sclera of the eye to provide drainage of fluids.

B. The Deficiency of Wong

In contrast, an embodiment of Applicant's invention is directed toward a torsion resistant stent that is provided with a cross portion for resisting torsional forces on a leg portion of the stent, thereby aiding in maintaining positioning of the stent within a tunnel formed intrasclerally in a globe of an eye. Where Wong is providing a drain, Applicant provides a device for manipulating the geometry of muscles on the eye. It is believed that use of Applicant's invention can aid influencing the geometry of the eye which may improve near distance eyesight.

Applicant submits that Claim 1 is not anticipated by Wong for at least two reasons. First, Wong does not teach providing an arcuate portion having "a radius of curvature from about 8 to about 9 mm," as recited in Claim 1. Instead, Wong discloses an implant matching the curvature of the sclera of the eye. See the Abstract of Wong. Column 2, lines 24-25, of Wong describe an

implant “curved to follow the configuration of the limbal region of the eye.” As shown in the attached reference, System of Ophthalmology, Vol. II The Anatomy of The Visual System, (Henry Kimmpton) 1961, p. 78-79, the scleral segment of the eye has a radius of 12 mm. Therefore, Wong does not teach a radius of curvature from about 8 to about 9 mm. For at least this reason, Wong is insufficient to sustain a rejection of 35 USC § 102 of Claim 1. Furthermore, no modification of Wong to provide such a radius is suggested, as Wong provides a drain functionality by matching the curvature of the sclera of the eye with a corrugated structure, which teaches against a structure having a radius different from that portion of the eye.

Secondly, Applicant notes that Claim 1 is directed to a scleral-tensioning stent. Applicant notes that Wong does not disclose such a stent, and is therefore also insufficient to sustain the rejection under 35 USC § 102 of Claim 1.

The Office Action asserts that functional language in the claims has been considered but not given much patentable weight because they indicate intended use and do not provide further structural limitation. Applicant submits that the recitation of the curvature of the arcuate portion is specific structural language that must therefore be given patentable weight. Secondly, the recitation of a scleral-tensioning stent requires structure capable of tensioning of the sclera. There is therefore, necessarily, a structure associated with a scleral-tensioning stent and this language can not be dismissed as simply intended use. Applicant submits that Wong does not teach either an arcuate portion as recited in the claims nor a scleral-tensioning stent and is therefore incapable of sustaining a rejection of Claim 1 under 35 USC § 102.

Applicant asserts that Claims 2, 5-6, 8 and 11-12 are patentable in part by way of their dependency from Claim 1. Additionally, regarding Claim 11, Applicant also asserts that Wong does not teach a cross portion flat on a bottom surface.

Regarding Claim 24, Applicant asserts that Wong is insufficient to sustain a rejection of Claim 24 under 35 USC § 102 at least because Wong does not teach or suggest a flange at a distal end of an elongated portion, as recited in Claim 24.

Applicant submits that Claims 25-27 and 29 are patentable in part by way of their dependency from Claim 24. Additionally, regarding Claim 25, as noted above in relation to Claim 1, Wong does not teach a stent having an arc of smaller radius than a radius of the globe of the eye proximate to the tunnel formed in the sclera, as Wong matches the curvature of the eye along the sclera. Furthermore, regarding Claim 26, Applicant asserts that Wong does not teach an arc ending at a first end of an elongated portion.

V. Claim Rejections – 35 USC § 103

Claims 3, 6, 17 and 28 are rejected as being unpatentable over U.S. Patent No. 4,521,210 to Wong. Applicant traverses this rejection. Applicant notes that Claims 3 and 17 have been cancelled without prejudice or disclaimer.

A. Claim 6

Applicant asserts that Claim 6 is patentable in part by way of its dependency from Claim 1. Applicant references the discussion above regarding the patentability of Claim 1 over Wong, and asserts that Wong is insufficient to teach or suggest all the limitations of Claim 1, from which Claim 6 depends. In view of the above, Applicant asserts that the rejection of Claim 6 under 35 USC § 103 should be withdrawn.

B. Claim 28

With respect to claim 28, Applicant asserts that Wong does not teach a top surface of an elongated portion narrower than a bottom surface of the elongated portion. Claim 28 is also patentable in part by way of its dependency from Claim 24, the patentability of which is discussed above. Applicant asserts that any modification of Wong in order to provide each of the elements of claim 28 is not suggested by Wong. The Office Action provides no support for the assertion that it would have been an obvious matter of design choice to make a top surface narrower than a bottom surface. Applicant notes that Wong is not a scleral-tensioning stent and no rationale is provided as to why it would have been obvious to make a top surface narrower than the bottom surface.

Applicant also notes that the case cited in the Office Action, In re Rose, 105 USPQ 237 (CCPA 1955) is not applicable. Specifically, In re Rose involved the storage and handling of lumber. The court affirmed the Board of Appeals, noting that, regarding bundles of lumber strips, “[t]he number of strips in a bundle, the number of bundles in a layer, the number of layers of bundles and the relative dimensions of the strips, the bundles and the package are all deemed matters of choice involving differences in degree and/or size” and not patentable distinctions. Here, as recited in Claim 28, the eye stent is provided and claimed with a specific structural shape to provide enhanced stability, not merely differences in degree or size from that in Wong ‘210.

VI. Newly-Added Claims

Claims 30-34 are newly added by this amendment and drawn to Group I and at least species

1. Applicant submits that Claim 30 is patentable over Wong in part because of its patentability from claim 24. Also, as discussed above in relation to Claim 1, Wong does not teach or suggest an arc having a radius of about 8 to about 9 mm, as recited in Claim 30.

Claim 31 is patentable in part by way of its dependency from Claim 1 and for reasons analogous to those discussed above in relation to Claim 28.

Claim 32 is patentable in part because Wong does not teach a generally capital t-shaped body nor a cross portion having a flat bottom surface.

Claim 33 is patentable in part because Wong does not teach a flange forming a capital T shape in combination with an elongated portion, as recited in Claim 33.

Claim 34 is patentable in part because of its dependency from Claim 33 and for the reasons discussed above in relation to Claim 28.

VII. Specification

The disclosure has been objected to because of a typographical error. While the Office Action asserts that “leg portion (6)” on line 11, page 15 should have been - leg portion (4) -, there is no “leg portion (6)” text on page 15 of the specification. Applicant has located the text at page 14, line 16, of the Office Action and made the appropriate correction by this amendment.

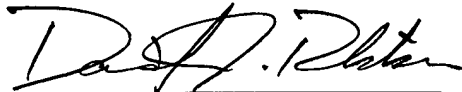
CONCLUSION

In view of the remarks set forth above, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If the Examiner feels that a further

telephone conference would expedite allowance/issuance of this case, or resolve any remaining issues, the Examiner is invited to contact the undersigned at (617) 856-8382.

Respectfully submitted,

BROWN RUDNICK BERLACK ISRAELS LLP

A handwritten signature in black ink, appearing to read "David J. Rikkers", written over a horizontal line.

Date: April 28, 2005

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